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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,853	04/16/2004	Thomas P. Foran	EMP-133US	2086
24314	7590	06/28/2005	EXAMINER	
JANSSON, SHUPE & MUNGER, LTD 245 MAIN STREET RACINE, WI 53403			COURSON, TANIA C	
			ART UNIT	PAPER NUMBER
			2859	

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/826,853

Applicant(s)

FORAN, THOMAS P.

Examiner

Tania C. Courson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. The election requirement stated in the last office action (filed May 3, 2005) is hereby repeated, and thus made **FINAL**.
2. Claims 1-7 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made **without** traverse in amendment filed on June 1, 2005.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 8 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Lung (US 1,082,163).

Lung discloses in Figures 1-7, a level device comprising:

With respect to claims 8 and 21:

- a) a cylinder (J) formed from a first material (Fig. 7), the cylinder having an inner surface defining a cavity and an outer surface (Fig. 7), a sleeve (N)

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formed from a second material and being molded around the cylinder (Fig. 7) and indicia (V) positioned on the outer surface (Fig. 7), the inner surface not being penetrated by the indicia (Fig. 7) and the indicia being bounded by the cylinder and the sleeve (Fig. 7);

b) wherein the indicia is at least one marker ring (V).

With respect to the preamble of the claim 8: the preamble of the claim has not been given any patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self – contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 9, 12, 14 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lung.

Lung discloses a level device, as stated above in paragraph 4.

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Lung further discloses wherein the cylinder and the sleeve extend from a first end to a second end (Fig. 3) and the cavity is partially filled with a liquid to define a bubble (Fig. 3), the cavity being sized to receive a first end closure at the first end and a second end closure at the second end (Fig. 3).

Lung does not disclose wherein first and second materials are acrylic, wherein indicia is hot stamped onto a cylinder and wherein the inner surface is machined to form a cavity having a desired shape.

Regarding claim 9: Lung discloses the cylinder (J) and the sleeve (N) made of materials. The particular type of material used to make the cylinder and the sleeve, absent any criticality, is only considered to be the use of a “preferred” or “optimum” material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have found obvious to provide using routine experimentation based, among other things, on the intended use of Applicant's apparatus, i.e., suitability for the intended use of Applicant's apparatus. See In re Leshin, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious. Therefore, one skilled in the art would change the type of material of the first and second materials in order to suit the needs of the user of the device.

Regarding claims 14 and 22: The method of forming (i.e. hot stamp, machined) the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight. Therefore, one skilled in the art would change the method

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of forming in order to suit the needs of the user of the device (i.e. to increase strength and durability).

7. Claims 15-17, 19-20 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lung (US 1,082,163).

Lung discloses a level device including the following:

- a) a cylinder (J) comprised of a first material (Fig. 7) and having an inner surface defining a cavity (Fig. 7), a second material (N) molded around the cylinder (Fig. 7);
- b) wherein the cylinder is molded and has an outer surface (Fig. 7), at least one marker ring (V) is embedded into the outer surface (Fig. 7), the marker ring not extending through the inner surface (Fig. 7) and the second material is molded around the marker ring such that the marker ring is enclosed between the first material and second material (Fig. 7);
- c) wherein a bubble is positioned in the cavity by partially filling the cavity with a liquid and enclosing the cavity with an end closure (Fig. 3);
- d) wherein the cavity is barrel-shaped (Fig. 3);
- e) wherein the desired shape is curvilinear (Fig. 5);
- f) wherein the cavity has a maximum diameter (Fig. 3) and the at least one marker ring is two marker rings such that the maximum diameter is positioned equidistant between the marker rings (Fig. 3).

Lung does not disclose the following:

- a) an inner surface being machined to form a cavity having a desired shape;
- b) wherein the first and second materials are the same acrylic material;
- c) wherein the first and second materials having a melting point and wherein the cylinder is solid and at a temperature less than the melting point when the second material is molded around the cylinder;
- d) wherein the first material is polycarbonate and the second material is acrylic.

With respect to the preamble of the claim 15: the preamble of the claim has not been given any patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self – contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

Regarding claim 15: The method of forming (i.e. inner surface being machined) the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight. Therefore, one skilled in the art would change the method of forming in order to suit the needs of the user of the device (i.e. to increase strength and durability).

Regarding claims 16 and 23: Lung discloses the cylinder (J) and the sleeve (N) made of materials. The particular type of material used to make the cylinder and the sleeve, absent any

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criticality, is only considered to be the use of a “ preferred ” or “ optimum ” material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant’s apparatus, i.e., suitability for the intended use of Applicant’s apparatus. See In re Leshin, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious. Therefore, one skilled in the art would change the type of material of the first and second materials in order to suit the needs of the user of the device.

Regarding the melting points of the materials: Lung discloses a cylinder (V) and a second material (N) having melting points but does not disclose a particular value for this parameter. However, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide a cylinder is solid at a temperature less than the melting point when the second material is molded around the cylinder, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the “ optimum range ” involves only routine skill in the art. In re Aller, 105 USPQ 233. Therefore, one skilled in the art would change the optimum range of the melting points of the materials in order to suit the needs of the user of the device.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant’s disclosure.

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The prior art cited on PTO-892 and not mentioned above disclose a level:

Beyer (US 6,546,638 B2)

Lindner et al. (US 5,651,186)

Drori (US 4,436,686)

Jacoff (US 3,593,428)

Wullschleger (US 2,752,693)

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tania C. Courson whose telephone number is (571) 272-2239.

The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez, can be reached on (571) 272-2245.

The fax number for this Organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Diego F.F. Gutierrez', written in a cursive style.

DIEGO F.F. GUTIERREZ
SUPERVISORY PATENT EXAMINER
GROUP ART UNIT 2859

TCC
June 26, 2005

CHRISTOPHER W. FULTON
PRIMARY EXAMINER